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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/522,492

11/21/2005

Richard P. Merry

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06/24/2009

3M INNOVATIVE PROPERTIES COMPANY

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EXAMINER

DUONG, THANH P

ART UNIT

PAPER NUMBER

1797

NOTIFICATION DATE

DELIVERY MODE

06/24/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

LegalUSDocketing@mmm.com

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Office Action Summary	Application No.	Applicant(s)	
	10/522,492	MERRY ET AL.	
	Examiner	Art Unit	
	TOM P. DUONG	1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 12-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Group I (claims 1-10 and 12-20) in the reply filed on 4/24/09 is acknowledged. The traversal is on the ground(s) that there is no specific citation of where WO 94/16134 disclosure supports the conclusion in the Office Action that the Group I and II claims lack the same or corresponding special technical features. This is not found persuasive because WO 94/16134 discloses a mat for mounting a pollution control comprising a non-intumescent material of magnesium aluminum silicate glass fibers, S2-Glass". Therefore, the recited structure does not contributed over the prior art.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-10 and 12-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 98/35144 (hereinafter WO '144) in view of Rogers et al. (5,290,522).

Regarding claims 1-2, 5-8, and 12-20, WO '144 discloses a mat for mounting a pollution control element (30) in a casing (11) of a pollution control device, said mat

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being a non-intumescent mat (page 15, lines 9-22) comprising at least 90% by weight based on the total weight of the mat of chopped magnesium aluminum silicate glass fibers, S2-GLASS (page 13, lines 26-31) that have a number average diameter of 51 μm or more and a length of 0.5 to 15 cm, said glass fibers being needle punched or stitch bonded (page 4, lines 19-30), said mat being free or substantially free of organic binder (0.5% organic binder); mount density of 0.2-0.7 g/cc (page 23, lines 11-17); mat for diesel engine (page 1, lines 1-10);

With respect to at least two layers of said chopped magnesium aluminum silicate glass fibers, wherein said at least two layers differ in their magnesium aluminum silicate glass fiber composition, WO '144 discloses a multilayer intumescent sheet comprising at least one non-intumescent layer and it would have been obvious in view of WO '144 to provide a multilayer mounting mats including a second layer of magnesium aluminum silicate glass fiber in order to provide a mounting system which is sufficiently resilient and compressible to accommodate the changing gap between the monolith and the metal housing over a wide range of operating temperatures and a large number of thermal cycles (page 5, lines 1-17) since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. WO '144 discloses the mounting mats with at least two layers with different intumescent properties (page 1, lines 1-10).

WO '144 discloses the same S2-glass as the claimed invention; thus, one of ordinary skill in the art would have expected the S2-glass of WO '144 inherently exhibits the same number average diameter and length as the claimed invention.

Note, the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a *prima facie* case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). “When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.” *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Therefore, the *prima facie* case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. *In re Best*, 562 F.2d at 1255, 195 USPQ at 433.

In any event, Rogers et al. teaches that it is desirable to provide the chopped magnesium aluminum silicate glass fibers with a fiber length of 0.5 -15 cm and a diameter ranging from 5 -20 μm (Col. 3, lines 58-62), at least 90% by weight of the total weight of the mat (Col. 1, lines 64-68); 10-12% Al_2O_3 , 1-12% MgO , and 52-70% SiO_2 (Col. 1, lines 45-62) and such fiber characteristic provide the advantage of processing the mat with high mechanical strength. Thus, it would have been obvious in view of Rogers et al. to one having ordinary skill in the art to modify the glass fiber of the applied references with the fiber diameter range as taught by Rogers et al. in order to gain the above advantages.

Regarding claims 3 and 4, WO '144 discloses composition, thickness, and width of the layers may be varied to fit any contemplated end use (page 9, lines 18-23).

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Regarding claims 9 and 10, WO '144 discloses the same mat for mounting a pollution control device; thus, one of ordinary skill in the art would have expected the device of WO '144 is capable of performing in the claimed vehicles.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TOM P. DUONG whose telephone number is (571)272-2794. The examiner can normally be reached on 8:00AM - 4:30PM (IFP).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Walter Griffin can be reached on (571) 272-1447. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Tom P Duong/
Primary Examiner, Art Unit 1797